



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Adress: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,038	12/15/2003	Eric David Harper	20503-4023	4020
34313	7590	07/21/2009		
ORRICK, HERRINGTON & SUTCLIFFE, LLP			EXAMINER	
IP PROSECUTION DEPARTMENT			DEGA, MURALI K	
4 PARK PLAZA			ART UNIT	PAPER NUMBER
SUITE 1600			3621	
IRVINE, CA 92614-2558				
		MAIL DATE	DELIVERY MODE	
		07/21/2009	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/736,038	Applicant(s) HARPER ET AL.
	Examiner Murali K. Dega	Art Unit 3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(o).

Status

- 1) Responsive to communication(s) filed on 25 March 2009.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-25 is/are pending in the application.
 4a) Of the above claim(s) None is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-25 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/DS/06) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Request for Continued Examination Under 37 C.F.R. §1.114

1. A request for continued examination ("RCE") under 37 C.F.R. §1.114, including the fee set forth in 37 C.F.R. §1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 C.F.R. §1.114, and the fee set forth in 37 C.F.R. §1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 C.F.R. §1.114. Applicant's submission filed on 25 March 2009 has been entered.

Acknowledgements

2. This Office action is in response to RCE filed on 25 March, 2009, in reply to the previous Office action mailed on 26 January, 2009.
3. Claims 1 - 25 are pending and have been examined.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
5. Claims 1, 11 and 21 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. See MPEP §2173.05(p) II. and the 112 2nd paragraph rejection below.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1, 11 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claims 1, 11 and 21 are indefinite because the claims are considered hybrid claims. See MPEP §2173.05(p) II. In particular, the claim is directed to neither a "process" nor a "machine" but rather embrace or overlap two different statutory classes of invention as set forth in 35 U.S.C. §101.

9. For example the claims recite "[a] system" for controlling, "[a] License management system" for controlling, "[a] computer" to perform. In light of this evidence, one of ordinary skill in the art could reasonably interpret these recitations as express intent by Applicants to claim a machine claim. Alternatively, these claims recite "enabling a predetermined use", "given software application and the one computer are identifiable by the server using a license" and "storing information concerning a license to operate the given software application" as well as other process language. One of ordinary skill in the art could also reasonably interpret these recitations as express intent by Applicants to claim a process claim. In light of this conflicting evidence, a person of ordinary skill in the art could reasonably interpret claim 56 to be drawn to either a product or process.

10. Therefore in accordance with §2173.05(p) II which states that a single claim must be drawn to either a product or process (but not both) and because a potential competitor of Applicants would not know whether *possession alone* of the claimed structure constituted infringement, or alternatively, if infringement required the *execution of the recited method steps*, the claims are indefinite. If Applicants overcome this particular 35 U.S.C. §112, 2nd paragraph rejection, the related 35 U.S.C. §101 rejection will also be withdrawn.

11. Claim 21 recites "A computer of a plurality of computers programmed to perform...". It is not clear if the Applicant is claiming a 'computer system' consisting of plurality of computers or 'one computer' among plurality of computers. To further the prosecution of the claims on the merits, the Examiner construes as "a computer system consisting of plurality of computers".

Necessary correction or explanation is required.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

13. Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Misra et al. (US 6,189,146), in view of Bergler et al. (US 7,343,297), herein after referred to as Bergler.

14. With regards to **claim 1:**

15. Misra discloses a system for controlling the use of a software application on a plurality of computers, the system comprising: a plurality of computers, each computer of the plurality of computers capable of running a given software application, a server having a server store, communication channels respectively permitting communication between each computer of the plurality of computers and the server, and a transaction arrangement operable respectively between each computer of the plurality of the computers and the server via the communication channels for enabling a predetermined use of the given software application by each computer of the plurality of computers, wherein the server controls the predetermined use of the given software application by one computer of the plurality of computers according to conditions stored in the server store, wherein the given software application and the one computer are identifiable by the server using a license, and wherein the license is returnable by the one computer to the server for use by another computer of the plurality of computers. (Abstract, figs. 3, 4, 5, 6, 7 and 8, col. 2, ll. 32-47, where a licensing server, multiple clients and use of standard communication methods are provided). Misra does not explicitly disclose licenses being returned by the computer to the server. However, Bergler teaches licenses being returned (Abstract, "automatically returned to the license server's

available pool", ¶ [0025]) to the license pool as part of license management by the server to assure the license availability to other computers in the network.

16. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Misra, so as to have included the step of returning the license that is not required by the computer, to the server, in accordance with Bergler, to ensure availability of licenses to other computers and thus reducing the cost of multiple licenses through usage optimization by returning the license by the one computer if he license is not being used.

17. With respect to **claim 2**:

18. Misra discloses wherein the transaction arrangement determining access of each computer of the plurality of computers to the given software application (Fig. 1, col. 6, II. 21-30 and col. 8, II.60-67, a license server distributing licenses and the client using the license to gain access to other applications is provided).

19. With respect to **claim 3**:

20. Misra discloses wherein the transaction arrangement determining parameters of operation for the given software application (Abstract, col. 2, II.62-76, col. 3, II.8-15 and col. 4, II.49-58, in which an automatic mechanism for obtaining license, license server determining the appropriate type of license for the client and the license server checking the client status is described).

21. With respect to **claim 4**:

22. Misra discloses wherein the server controlling the number of the plurality of computers authorized to run the given software application (Fig. 3, col. 7, table 1 and col. 10, ll. 51-59, where in the server keeps track of clients receiving licenses).

23. With respect **claim 5**:

24. Misra discloses wherein the software application comprises a computer program operable under the license, and wherein the transaction arrangement comprises a license management system for verifying the availability for each computer of the plurality of computers of the license for the computer program (Fig. 3, col. 8, ll. 35-52 and col.12, ll. 8-27, the license management system is described).

25. With respect to **claim 6**:

26. Misra discloses wherein the license management system controls license rights available under the license, and configures each computer of the plurality of computers to operate according to the license rights (Abstract, col. 3, ll. 8-15, col. 10, ll. 30-37 and col. 10, ll. 45-50 , a rights management and a system to configure clients operating system is provided).

27. With respect to **claim 7**:

28. Misra discloses wherein the license management system stores therein different possible license rights available under the license, selects a license right of the license rights from the server store, and activates the license right for each compute of the plurality of computers (Abstract, fig. 3, col. 3, ll. 16-26 and col. 6, ll. 50-64, where license information storing and managing is described).

29. With respect to **claim 8**:

30. Misra discloses wherein the each computer of the plurality of computers stores details of the license rights and updates details on use of the computer program (Abstract, fig. 3, col. 3, ll. 16-26 and col. 6, ll. 50-64, where license information storing and managing is described).
31. With respect to **claim 9**:
32. Misra discloses wherein the license management system transfers the license from one computer of the plurality of computers to another computer of the plurality of computers (Abstract, fig. 3, col. 11, ll. 36-45 and col. 2, ll32-47, a regular communication between clients and license server being facilitated).
33. With respect to **claim 10**:
34. Misra discloses wherein the license management system inhibits operation of the computer program on the one computer following the transfer (Abstract, fig. 3, col. 11, ll. 36-45, col. 2, ll32-47 and col. 3, ll. 16-26, a method to prevent unauthorized usage is provided).
35. With respect to **claim 11**:
36. Misra discloses a license management system for controlling the use of a given software application respectively on a plurality of computers, the license management system comprising:
 - a. an application store associated with each computer of the plurality of computers for storing a copy of the given software application (Abstract, fig. 3, col. 3, ll. 16-26 and col. 6, ll. 50-64, where license information storing and managing is described).

- b. a license store for storing information concerning a license to operate the given software application, wherein the given software application comprises a computer program operable under the license (Abstract, fig. 3, col. 3, ll. 16-26 and col. 6, ll. 50-64, where license information storing and managing is described).
- c. a software identification store for storing identification information relating to the given software application (Abstract, fig. 3, col. 3, ll. 16-26 and col. 6, ll. 50-64, where license information storing and managing is described).
- d. a computer identification store for storing identification information relating to each computer of the plurality of computers (Abstract, fig. 3, col. 3, ll. 16-26 and col. 6, ll. 50-64, where license information storing and managing is described).
- e. a transaction arrangement operatively linking the application store, the license store, the software identification store and the computer identification store, the transaction arrangement being responsive to a request from a one computer of the plurality of computers for use of the given software application to verify whether the given software application is available for use the one computer of the plurality of computers and to transmit to the one computer the license to use the given software application in the event that the given software application is so available wherein the license is returnable by the one computer to the server for use by another computer of the plurality of computers (Abstract,

fig. 3, col. 3, ll. 16-26 and col. 6, ll. 50-64, where license information storing and managing is described).

f. Misra does not explicitly disclose licenses being returned by the computer to the server. However, Bergler teaches licenses being returned (Abstract, "automatically returned to the license server's available pool", ¶ [0025]) to the license pool as part of license management by the server to assure the license availability to other computers in the network.

g. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Misra, so as to have included the step of returning the license that is not required by the computer, to the server, in accordance with Bergler, to ensure availability of licenses to other computers and thus reducing the cost of multiple licenses through usage optimization by returning the license by the one computer if the license is not being used.

37. With respect to **claim 12**:

38. Misra discloses a server providing the license store, the software identification store and the computer identification store (Abstract and fig. 3, where a server that stores license information is described).

39. With respect to **claim 13**:

40. Misra discloses wherein the server controls the number of licenses available for the given software application (Fig. 3, col. 7, table 1 and col. 10, ll. 51-59, where in the server keeps track of clients receiving licenses).

41. With respect to **claim 14**:
 42. Misra discloses wherein server transfers a license from one computer of the plurality of computers to another computer of the plurality of computers (Abstract, figs. 3 and 4)
 43. With respect to **claim 15**:
 44. Misra discloses wherein the server inhibits operation of the computer program on the one computer following the transfer (Abstract, fig. 3, col. 11, ll. 36-45, col. 2, ll32-47 and col. 3, ll. 16-26, a method to prevent unauthorized usage is provided).
 45. With respect to **claim 16**:
 46. Misra discloses further comprising a license store provided at each computer of the plurality of computers for storing locally information concerning the license (Abstract and col. 3, ll. 22-25).
 47. With respect to **claim 17**:
 48. Misra discloses parameters of operation for the given software application (Abstract, col. 2, ll.62-76, col. 3, ll.8-15 and col. 4, ll.49-58, in which an automatic mechanism for obtaining license, license server determining the appropriate type of license for the client and the license server checking the client status is described).
 49. With respect to **claim 18**:
 50. Misra discloses wherein the transaction arrangement verifies license rights available under the license (Fig. 3 and 5, col. 8, ll. 35-52, col.12, ll. 8-27, col. 13, ll. 65-67 and col. 14, ll. 1-21, the license management system is described).
 51. With respect to **claim 19**:

52. Misra discloses license store having a data store for storing therein different possible license rights available under the license, and wherein the transaction arrangement selects a license right of the license rights and activates the license right for each computer of the plurality of computers (Abstract, fig. 3 and 4, col. 8, ll. 35-67 and col.12, ll. 8-27, the license management system is described along with selection and activation of the said licenses).

53. With respect to **claim 20**:

54. Misra discloses wherein each computer of the plurality of computers stores details of the license right, and updates the license rights according to the current state of the license right on use of the computer program (Abstract, fig. 3 and 4, col. 8, ll. 35-67 and col.12, ll. 8-27, the license management system is described along with selection and activation of the said licenses).

55. With respect to **claim 21**:

56. Misra discloses a computer of plurality of computers programmed to perform a transaction for enabling the operation of a given software application, the transaction comprising:

h. Creating a license file for a license to operate the given software application, wherein the license is returnable by one computer of the plurality of computers to the server for use by another computer of the plurality of computers (Abstract, tables 1, 2, 3, 4 and 5, col. 2, ll. 37-47 and col. 7, ll. 13-20 where in the client functions are described and as well as encryption is provided).

- i. Assigning to the license file a serial number representing the given software application (Abstract, tables 1, 2, 3, 4 and 5, col. 2, II. 37-47 and col. 7, II. 13-20 where in the client functions are described and as well as encryption is provided).
- j. Assigning to the license file an identification code representing the computer (Abstract, tables 1, 2, 3, 4 and 5, col. 2, II. 37-47 and col. 7, II. 13-20 where in the client functions are described and as well as encryption is provided).
- k. Transmitting to a server a request to execute the given software application (Abstract, tables 1, 2, 3, 4 and 5, col. 2, II. 37-47 and col. 7, II. 13-20 where in the client functions are described and as well as encryption is provided).
- l. The request including the serial number and the identification code; in response to a reply from the server updating the license file with information concerning the availability of the license; and reading the license file for establishing whether the given software application can be executed (Abstract, tables 1, 2, 3, 4 and 5, col. 2, II. 37-47 and col. 7, II. 13-20 where in the client functions are described and as well as encryption is provided).
- m. Misra does not explicitly disclose licenses being returned by the computer to the server. However, Bergler teaches licenses being returned (Abstract, "automatically returned to the license server's available pool", ¶ [0025]) to the license pool as part of license management by the server to assure the license availability to other computers in the network.

n. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Misra, so as to have included the step of returning the license that is not required by the computer, to the server, in accordance with Bergler, to ensure availability of licenses to other computers and thus reducing the cost of multiple licenses through usage optimization by returning the license by the one computer if the license is not being used.

57. With respect to **claim 22**:

58. Misra discloses wherein the transaction further comprises: in response to reply from the server updating the license file with details of license rights transmitted from the server; and configuring the computer according to the license rights to execute a predetermined software feature incorporated in the given software application (Abstract and col. 11, ll. 25-45, a license granting process is described).

59. With respect to **claim 23**:

60. Misra discloses a method for controlling the execution of a given software application in a computer system, the computer system including a server and a plurality of computers, the method comprising:

o. Creating a license file on one computer of the plurality of computers for a license to operate the given software application wherein the license is returnable by the one computer to the server for use by another computer of the plurality of computers (Abstract, tables 1, 2, 3, 4 and 5, col. 2, ll. 37-47 and col. 7, ll. 13-20 where in the client functions are described and as well as encryption is provided).

- p. License assigning to the license file an identification code representing the one computer (Abstract, tables 1, 2, 3, 4 and 5, col. 2, ll. 37-47 and col. 7, ll. 13-20 where in the client functions are described and as well as encryption is provided).
- q. Formulating a request to execute the given software application at the computer, the request including a serial number associated with the given software application and an identification code of the one computer (Abstract, tables 1, 2, 3, 4 and 5, col. 2, ll. 37-47 and col. 7, ll. 13-20 where in the client functions are described and as well as encryption is provided).
- r. Transmitting the request with the serial number and the identification code to the server; in response to a reply from the server updating the license file with information concerning the availability of the license; and reading the license file for establishing the status of the license at the one computer (Abstract, tables 1, 2, 3, 4 and 5, col. 2, ll. 37-47 and col. 7, ll. 13-20 where in the client functions are described and as well as encryption is provided).
- s. Misra does not explicitly disclose licenses being returned by the computer to the server. However, Bergler teaches licenses being returned (Abstract, "automatically returned to the license server's available pool", ¶ [0025]) to the license pool as part of license management by the server to assure the license availability to other computers in the network.
- t. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Misra, so as to have

included the step of returning the license that is not required by the computer, to the server, in accordance with Bergler, to ensure availability of licenses to other computers and thus reducing the cost of multiple licenses through usage optimization by returning the license by the one computer if he license is not being used.

61. With respect to **claim 24**:
 62. Misra discloses storing at the server information concerning license rights available under the license; in response to the request from the one computer selecting license rights to be applied to the one computer and transmitting details of the selected rights to the one computer; in response to the reply from the server updating the license file with details of the selected license rights transmitted from the server; and configuring the one computer according to the selected license rights to execute a predetermined software feature incorporated in the given software application (Abstract, tables 1, 2, 3, 4 and 5, col. 2, ll. 37-47 and col. 7, ll. 13-20 where in the client functions are described and as well as encryption is provided).
63. With respect to **claim 25**:
 64. Misra discloses updating the license file on an ongoing basis during use of the predetermined feature by the one computer to record a current state of the license; and when the license is no longer required transmitting details from the updated license file of the current state to the server (Abstract, tables 1, 2, 3, 4 and 5, col. 2, ll. 37-47 and col. 7, ll. 13-20 where in the client functions are described and as well as encryption is provided).

Response to Arguments

65. Applicant's arguments filed on 25 March 2009, have been fully considered but they are not persuasive.
66. Applicant argues that the new reference was not previously considered and refers to Page 15 ¶ 56. The Examiner agrees with the Applicant, however, rejects the request for withdrawal of the final rejection mailed on 26 January, 2008.
67. The new grounds of rejection were necessitated by the amendments filed on 29 October 2009, by the Applicant, in reply to the initial Non-Final rejection dated 29 May 2008.
68. Applicant asserts that the combination of Bergler and Misra is improper. The Examiner respectfully disagrees.
69. The teachings of Misra in combination of Bergler, represent the number of ways a license can be returned by the user or can be re-issued for different reasons. It is obvious to the person having ordinary skill in the art that the license or the rights surrendered by the user, either voluntarily or as mandated by the system, can and will be re-issued to the same user as and when necessary, as per the teachings of Misra and Bergler.
70. Applicant's assertions that "Bergler cannot be properly combined with Misra due to the amendment of claims, indicating the voluntary nature of returning of a license, is not persuasive.

71. The prior art does teach the automatic return of license, is functional equivalent of voluntary return of the license by the user, in order to get a new license with extended expiration date.

72. On page 11, line 12, the Applicant cites "claims 2-10 that depend from claim 1 are not patentable under 35 U.S.C. § 102(b) over Misra in view of Bergler". The Examiner is not clear if the Applicant is agreeing with the prior rejection based on the merits or it is a typographical error.

Conclusion

73. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

u. All additional references cited relate to various license management and distribution systems that are at least generally applicable to the disclosed invention.

74. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Murali K. Dega whose telephone number is (571)270-5394. The examiner can normally be reached on Monday to Thursday 7.30 to 4.00 ET.

75. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Fischer can be reached on (571)272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

76. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. K. D./
Examiner, Art Unit 3621

/EVENS J. AUGUSTIN/
Primary Examiner, Art Unit 3621